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PTO/SB/64 (09-04)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Docket Number (Optional)

KM-M1

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

First named inventor: MANSMANN

Application No.: 09/544,341

Art Unit: 3738

Filed: April 6, 2000

Examiner: D.J. Isabella

Title: SEMI-PERMEABLE MEMBRANES TO ASSIST IN CARTILAGE REPAIR

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OFFICE OF PETITIONS

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (703) 872-9306

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

Small entity-fee \$ 685.00 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

Other than small entity – fee \$ _____ (37 CFR 1.17(m))

2. Reply and/or fee

- A. The reply and/or fee to the above-noted Office action in the form of Response With Amendment (identify type of reply):

has been filed previously on _____
 is enclosed herewith.

- B. The issue fee and publication fee (if applicable) of \$ _____
 has been paid previously on _____
 is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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3. Terminal disclaimer with disclaimer fee

- Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.



Signature

October 26, 2004

Date

Patrick D. Kelly

30,650

Typed or printed name

Registration Number, if applicable

11939 Manchester #403

314-822-8558

Address

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Enclosures: Fee Payment Reply Terminal Disclaimer Form Additional sheets containing statements establishing unintentional delay Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (703) 872-9306.

26 October 2004

Date



Signature

Patrick D. Kelly

Typed or printed name of person signing certificate



Docket No. KM-M1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of MANSMANN)
Serial No. 09/544,341) Examiner: D.J. Isabella
Filed April 6, 2000) Art Unit 3738

Title: SEMI-PERMEABLE MEMBRANES TO ASSIST IN CARTILAGE REPAIR

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STATEMENT OF FACTS BY ATTORNEY

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MS Office of Petitions
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Alexandria, VA 22313

1. The undersigned, who is the attorney of record in the above-identified application, hereby submits this statement of fact in support of a petition to revive the above-identified application.

2. This application was allowed to become abandoned, after receipt of an Office Action mailed on May 20, 2003, because of a miscommunication between the Inventor/Applicant (Dr. Kevin Mansmann, an orthopedic surgeon) and the undersigned attorney. The mistaken communication was recognized just recently, during work on a related PCT application. This petition is being submitted promptly after the mistake was recognized.

3. The mistaken communication arose from an extensive overlap between the subject application, and a second utility application, serial number 10/677,444, attorney docket KM-GEL-2, filed on October 2, 2003. The '444 application (a continuation-in-part of an earlier application that issued as US patent 6,629,997 on October 7, 2003) discloses a type of chemical treatment of a cartilage implant with a hydrogel surface, to

provide the hydrogel with a treated surface membrane that allows it to interact in an improved manner with synovial fluid in a joint.

4. This current application also relates to surface membranes on surgical implants. While the primary focus of the current '341 application initially was on resorbable fibrous matrices, which can protect and nurture transplanted cells that can regenerate cartilage, the Examiner discovered and cited an item of prior art (not previously known to the Applicant or attorney) that directly anticipated membranes on the surfaces of such resorbable implants designed for cell transplants leading to cartilage regeneration. Both the Applicant/Inventor and the undersigned attorney recognized that the newly-cited prior art would require the claims in this current '341 application to be narrowed, in a way that limits all remaining claims to hydrogels made of synthetic polymers.

5. This reduced the scope and coverage of the subject '341 application, so that it heavily overlaps with application 10/677,444, filed in October 2003. Both applications relate to synthetic hydrogel polymers that are surface-treated to provide them with membrane-type outer layers having physical and chemical traits that are different from the underlying hydrogel material.

5. Because of the heavy overlap between those two cases, confusion arose between the Applicant/Inventor and the undersigned attorney, when we discussed the application about the hydrogel polymer with the surface layer. The Applicant/Inventor believed that the earlier application on membranes was still pending, while the undersigned attorney believed that discussions they had about membranes on hydrogel polymers were referring to the '444 application filed in October 2003.

6. This confusion and inadvertent misunderstanding came to light as we prepared a Patent Cooperation Treaty application that

was filed earlier this month, which claimed a priority date based on the October 2003 US patent application. As we discussed the contents of that PCT application, and as we both began discussing "the membrane application", it became clear that we were using a single phrase to refer to two different applications.

7. It was never the Applicant/Inventor's intent to allow application number 09/544,341 to become abandoned, or to inject any delay into the proceedings on that application. He believed and assumed that it was gradually working its way through the Patent Office, toward allowance.

8. The undersigned attorney made an inadvertent error, in believing that the '444 application had superseded the '341 application, and in believing that that position had been communicated adequately to the Applicant/Inventor.

9. The delay that was created in the proceedings on subject application number 09/544,341 was not intended, in any way, by either the Applicant/Inventor or the undersigned attorney, to inject delay into the prosecution of this application. Instead, the miscommunication between us was entirely inadvertent and unintentional, and the problem is being corrected promptly once we recognized the error and the problem.

10. A response to the Office Action dated 30 May 2003 is enclosed, which includes (i) cancellation of all previous claims (i.e., Claims 1-13), and substitution of a new set of claims, 14-23, all of which are limited to hydrogels made of synthetic polymers.

I further declare that all statements made of my own knowledge are true, and that all statements made on information and belief are believed to be true, and that I have been warned that willful false statements and the like are punishable by fine or imprisonment or both, under 18 U.S.C. § 1001 and may jeopardize the validity of the application or any patent issuing

thereon.

Respectfully submitted,



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